

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Letters Patent of:

John E. Jones

Customer No.: 41230

Patent No. 7,635,082 B2

Confirmation No.: 8084

Issued: December 22, 2009

Art Unit: 2876

For: CURRENCY DISPENSER

Examiner: Daniel A. Hess

REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT

Mail Stop Patent Extension
COMMISSIONER FOR PATENTS
Alexandria, Virginia 22313-1450

Dear Commissioner:

Pursuant to 37 C.F.R. § 1.705(d), Applicants request reconsideration of the patent term adjustment (“PTA”) indicated on U.S. Patent No. 7,635,082, which issued on December 22, 2009, from Application No. 10/773,827. The PTA printed on the patent is 1055 days. Applicants believe that the correct PTA is 1,658 days. This Request for Reconsideration of Patent Term Adjustment is being filed within two months of the issuance of the patent, and is thus timely. *See* 37 C.F.R. § 1.705(d). Because the appropriate PTA under 37 C.F.R. § 1.702(b) could not be calculated until the issuance of the patent, the Applicants could not have raised the following issue in an application for PTA under 37 C.F.R. § 1.705(b).

The fee set forth in 37 C.F.R. § 1.18(e) is being submitted concurrent with this filing.

I. The Corrected PTA And Support From 37 C.F.R. § 1.702

The Applicants are entitled to a PTA of 1,658 days. Under 35 U.S.C. § 154(b)(1)(A), (b)(2)(C), and 37 C.F.R. § 1.702(a), Applicants are entitled to 1118 days of adjustment. Under 35 U.S.C. § 154(b)(1)(B), and 37 C.F.R. § 1.702(b), Applicants are entitled to an additional 603 days of adjustment. Under 35 U.S.C. § 154(b)(2)(C), and 37 C.F.R. § 1.704, this adjustment is reduced by 63 days. The calculations for the above adjustments are provided below. Accordingly, the total adjustment should be 1,658 days.

The Court of Appeals for the Federal Circuit has recently made clear that Applicants are entitled to PTA under both 35 U.S.C. § 154(b)(1)(A) and 154(b)(1)(B), as long as no day is counted twice. *See Wyeth v. Dudas*, No. 2009-1120 (Fed. Cir., Jan. 7, 2010). The *Wyeth* court explained that the only way that the periods of time specified by Sections 154(b)(1)(A) and (B) can overlap is if they occur on the same day. *Id.* at 8. The court further explained, “Before the three-year mark, ‘no overlap’ can transpire between the A delay [35 U.S.C. § 154(b)(1)(A)] and the B delay [35 U.S.C. § 154(b)(1)(B)] because the B delay has yet to begin or take any effect.” *Id.* Thus, in Applicants’ case, the “B delay” began on February 6, 2007, not before. *See Id.* The “A delay,” 35 U.S.C. § 154(b)(1)(A), that Applicants are entitled to, accrued in the period between April 6, 2005 and April 28, 2008. There are 603 days of “B delay” that do not overlap the “A delay” from April 28, 2008 until the issue date of December 22, 2009. Accordingly, under controlling case law, Applicants are entitled to the sum of the “A delay” and non-overlapping “B delay,” reduced by any amount specified in 35 U.S.C. 154(b)(2)(C). As calculated below, this adjusted total is 1,658 days.

II. The Relevant Dates Specified In 37 C.F.R. §§ 1.703(a)-(e)

Under 35 U.S.C. § 154(b)(1)(A) and 37 C.F.R. § 1.703(a)(1), Applicants are entitled to an adjustment of 1118 days. Under 37 C.F.R. § 1.703(a)(1), Applicants are entitled to an adjustment of the number of days, if any, in the period beginning on the day after the date that is fourteen months after the date on which the application was filed and ending on the date of mailing of an action under 35 U.S.C. § 132. The application was filed on February 6, 2004. Fourteen months from that date was April 6, 2005. A Requirement for Restriction/Election was mailed on April 28, 2008. Thus, the number of days under § 1.703(a)(1) is 1118 days. 37 C.F.R. § 1.703(a)(2)-(6) do not apply.

Under 35 U.S.C. § 154(b)(1)(B) and 37 C.F.R. § 1.703(b), Applicants are entitled to an additional adjustment of 603 days. Specifically, under 37 C.F.R. § 1.703(b), Applicants are entitled to an adjustment of the number of days in the period beginning on the day after the date that is three years after the date on which the application was filed and ending on the issue date of the patent. The three year date was February 6, 2007, and the patent issued on December 22, 2009. This would result in an additional 1050 days. Of those days, each of the days between February 6, 2007 and August 28, 2008, overlaps with “A delay.” This results in a reduction of additional “B delay days” of 447 days. Accordingly, the additional adjustment due is 603 days.

37.C.F.R. §§ 1.703(c)-(e) do not apply.

III. The Patent Is Not Subject To A Terminal Disclaimer

The above-referenced patent that is the subject matter of this request is not subject to a terminal disclaimer.

IV. The Reduction In PTA Due To 37 C.F.R. § 1.704

Under 35 U.S.C. § 154(b)(2)(C) and 37 C.F.R. § 1.704(b), the PTA is reduced by the number of days in excess of three months in responding to an office action. Applicants responded to the September 4, 2008 non-final Office action on February 4, 2009. The time in excess of three months for this response was 62 days. An information disclosure statement was subsequently filed on February 5, 2009 or an additional one day after the response to the September 4, 2008 non-final Office action. There are no other reductions in adjustment that apply. Thus, the total reduction to PTA should be 63 days.

CONCLUSION

Applicants respectfully request reconsideration of the PTA and a determination that Applicants are entitled to 1,658 days (*i.e.*, 1118 days plus 603 days minus 63 days) of PTA.

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It is believed that no additional fees are due except for the fee set forth in 37 C.F.R. § 1.18(e); however, should any additional fees be required, or credits be due, the Commissioner is authorized to deduct the fees from, or credit the overpayments to, the Nixon Peabody Deposit Account No. 50-4181, Order No. 247171-000306USPT.

Respectfully submitted,

Dated: February 19, 2010

/Joey C. Yao, Reg. No. 63,810/

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